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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,666	09/12/2001	Sangeetha Narasimhan	10007341-1	7568

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EXAMINER	
PHILLIPS, HASSAN A	

ART UNIT	PAPER NUMBER
2151	

DATE MAILED: 08/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/954,666	NARASIMHAN ET AL.	
	Examiner	Art Unit	
	Hassan Phillips	2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 June 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-8,10-15 and 17-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-8, 10-15, 17-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1) This action is in response to amendments received, June 23, 2004.

Response to Arguments

1) Applicant's arguments, see page 9, 5th paragraph, and page 12, 1st paragraph, filed June 23, 2004, with respect to the rejection(s)of claim(s) 6, 14, 21, and 24 under 35 U.S.C. 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Amstein et al. (hereinafter Amstein) U.S. patent 5,793,966.

Claim Rejections - 35 USC § 103

1) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2) Claims 2-6, 10-14, 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halliwell et al. (hereinafter Halliwell) U.S. patent 5,564,051 in view of Amstein.

3) In considering claims 6, 14, and 21, Halliwell discloses a method for obtaining a service comprising:

a) identifying a service needed to perform a processing function in a processor based system coupled to a network, and searching at least one remote device on the network for the service to perform the processing function, (col. 1, lines 46-61).

Although the disclosed method of Halliwell shows substantial features of the claimed invention, it fails to explicitly disclose:

a) consulting a directory that associates the service with a remote device.

Nevertheless, consulting directories that associate services with remote devices was well known in the art at the time of the present invention. This is shown by Amstein in a similar field of endeavor that teaches the creation and maintenance of online services. More specifically, in Amstein's discussion of the prior art Amstein shows:

a) consulting a directory that associates a service with a remote device being typical for online services, (col. 1, lines 24-32).

Thus, it would have been obvious to one of ordinary skill in the art to modify the teachings of Halliwell to show, in the step of searching at least one remote device on the network for the service to perform the processing function, consulting a directory that associates the service with the at least one remote device. This would have been an essential step in obtaining the service if the service was located in more than one remote location, Amstein, col. 1, lines 33-41.

4) In considering claims 2, 10, and 17, Halliwell further discloses:

a) determining a local availability of the service, and searching at least one remote device on the network for the service, to perform the processing function, when the service in not locally available, (col. 1, lines 46-61).

5) In considering claims 3, 11, and 18, Halliwell further discloses:

a) finding a first revision of the service that is locally available, and searching at least one remote device on the network for a second revision of the service that is later than the first revision, (col. 2, lines 33-41).

6) In considering claims 4, 12, and 19, Halliwell further discloses:

a) automatically downloading the service from at least one remote device when the service is found thereon, and automatically installing the service in the processor based system to perform a processing function, (col. 3, lines 23-33).

7) In considering claims 5, 13, and 20, it is implicit that the method of Halliwell comprises a means for requesting a performance of the processing function on at least one remote device when the service is found thereon, and storing a data result, in the

processor based system, that was generated by the at least one remote device. See col. 2, lines 42-56.

8) Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chan et al. (hereinafter Chan) U.S. patent 6,073,147, in view of Amstein.

9) In considering claim 24, Chan discloses a method for obtaining service, comprising:

a) identifying whether a font is stored in a font directory accessible by a processor based system, the font being included in a document to be rendered by the processor based system, the processor based system being coupled to a network, (col. 3, lines 62-67, col. 4, lines 1-4);

b) searching at least one remote device on the network for the font to render the document when the font is not stored in the font directory, (col. 4, lines 4-5);

c) automatically downloading the font form the remote device if the font is found thereon and installing the font in the processor based system, and performing the rendering operation using the font.

Although the disclosed method of Chan shows substantial features of the claimed invention, it fails to explicitly disclose:

a) consulting a directory that associates the font with a remote device.

Nevertheless, consulting directories that associate services with remote devices was well known in the art at the time of the present invention. This is shown by Amstein in a similar field of endeavor that teaches the creation and maintenance of online services. More specifically, in Amstein's discussion of the prior art Amstein shows:

a) consulting a directory that associates a service with a remote device being typical for online services, (col. 1, lines 24-32).

Thus, it would have been obvious to one of ordinary skill in the art to modify the teachings of Chan to show, consulting a directory that associates the font with the at least one remote device coupled to a network. This would have been an essential step in obtaining the font if the font was located in more than one remote location, Amstein, col. 1, lines 33-41.

10)Claims 7, 8, 15, 22, 23, are rejected under 35 U.S.C. 103(a) as being unpatentable over Halliwell in view Amstein, and further in view of Chan.

11)In considering claims 7, 15, and 22, although the disclosed method of Halliwell and Amstein shows substantial features of the claimed invention, it fails to explicitly disclose:

a) the service being a font, and the processing function rendering a digital document.

Nevertheless, in a similar field of endeavor, Chan discloses a method for obtaining a service comprising:

a) examining a digital document to determine a font included therein, wherein the service is a font and the processing function entails rendering the digital document, (col. 2, lines 15-23).

Given the teachings of Chan, it would have been apparent to one of ordinary skill in the art to modify the teachings of Halliwell and to have the processing function in the processor coupled to the network examine a digital document to determine a font included therein, wherein the service is a font and the processing function entails rendering the digital document. This would have saved large amounts of memory by obtaining fonts remotely, and would have also allowed for the viewing of documents which contained fonts that were not immediately available to the processor, Chan, col. 2, lines 6-14.

12)In considering claims 8 and 23, although the disclosed method of Halliwell and Amstein shows substantial features of the claimed invention, it fails to explicitly disclose:

a) downloading a font from a remote device after determining a font is not stored in the processor-based system.

Nevertheless, Chan discloses:

a) determining whether a font is stored in a processor based system, searching a remote device on a network for the font, and automatically downloading the font from the remote device, (col. 2, lines 15-23).

Given the teachings of Chan, it would have been apparent to one of ordinary skill in the art to modify the teachings of Halliwell to search at least one remote device on the network when it is determined that a font is not stored in a font directory in the processor based system, download the font from the remote device, and install the font in the processor based system. This would have would have allowed for the viewing of documents containing fonts that were, prior to downloading, not immediately available to the processor, Chan, col. 2, lines 6-14.

13)Claims 25-27, are rejected under 35 U.S.C. 103(a) as being unpatentable over Halliwell in view Amstein, and further in view of Collie et al. (hereinafter Collie), U.S. patent 6,269,377.

14)In considering claims 25-27, although the disclosed method of Halliwell and Amstein shows substantial features of the claimed invention, it fails to explicitly disclose:

a) Presenting a manual search prompt upon failure to locate the service.

Nevertheless, presenting a manual search prompt upon failure to locate an item was well known in the art at the time of the present invention. Collie teaches this in his discussion of the prior art. More specifically, Collie shows:

a) Prompting a user to manually locate a source for installing a product upon failure of an application locating the source, (col. 3, lines 16-27).

Thus, it would have been obvious to one of ordinary skill in the art to modify the teachings of Halliwell to show, presenting a manual search prompt on a display device

upon a failure to locate the service on the at least one remote device, and executing an application to perform a manual network search for the service. Doing so would have provided a user with the means to manually locate the service needed, and would have prevented a premature termination of the search for the service.

Conclusion

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Halliwell et al., U.S. Patent 5,564,051, discloses a system and method for automatically obtaining services needed for application programs.

Chan et al., U.S. Patent 6,073,147, discloses a system and method for automatically obtaining font services.

Amstein et al., U.S. Patent 5,793,966 discloses a well-known method for obtaining services by consulting a directory.

Collie et al., U.S. Patent 6,269,377 discloses a well-known method for prompting a user to locate an item manually upon failure for an application to locate the item.

2) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hassan Phillips whose telephone number is (703) 305-8760. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (703) 308-6687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HP/
8/12/04

ZARNI MAUNG
PRIMARY EXAMINER